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EXAMINER

BEISNER, WILLIAM H

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 06/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/493,741	LEBL, MICHAL
Examiner	Art Unit	
William H. Beisner	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 27-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 27-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 02 April 2003 is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 April 2003 has been entered.

Drawings

2. The corrected or substitute drawings were received on 02 April 2003. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 27, 28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by American Hospital Supply (GB 1 241. 539).

The reference of American Hospital Supply discloses a centrifuge device (See Figure 9) that includes a rotor (13) rotatable about an axis of rotation that holds reaction vessels (26) in a

fixed position tilted away from the axis of rotation. The reference discloses that the lower ends of the tubes can be displaced inwardly, the tubes tilt away from the axis of rotation (See page 2, lines 90-96 and Figure 9). The reaction vessels are communicated with a waste reservoir (65) with a tube (64) that is connected to the bottom of housing (18 and 10). Housing (18) can also be considered a waste reservoir connected to the bottom of the centrifuge. The rotor includes a liquid distribution system (39) and the centrifuge is controlled by computer (36).

5. Claims 27, 28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Genese et al.(US 3,712,535).

The reference of Genese et al. discloses a centrifuge device (See Figure 2) that includes a rotor (10) rotatable about an axis of rotation that holds reaction vessels (38) in a fixed position tilted away from the axis of rotation (See position A in Figure 2 and column 6, lines 28-49). The reaction vessels are communicated with a windage bowl (collection vessel) (40) with a drain opening (See column 4, lines 49-51). The rotor includes a liquid distribution system (42) and the centrifuge is controlled by computer (73). With respect to the claimed waste reservoir connected with a tube to the centrifuge, the reference discloses that the drainage port of the windage bowl (40) is connected via the external connection (tube) (204) to a catch bottle (waste reservoir) (See column 12, lines 63-68).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 29/27 and 29/28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamai (JP 64-83153) in view of Genese et al.(3,712,525).

The reference of Tamai discloses a centrifuge device with a rotor (2) that supports a plurality of microplate vessels (3). The device includes a waste reservoir (30) to hold liquids expelled from said reaction vessels.

While the reference of Tamai discloses holding a plurality of microtiter plates, the claims differ by reciting that the plates are held in a tilted position away from the axis of rotation of the rotor.

The reference of Genese et al. discloses that it is known in the art to decant a vessel in a centrifuge device using a negative tilt (See column 6, lines 28-47).

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the holder of the primary reference so as to fix the vessels in an outward tilt for the known and expected result of ensuring the emptying of the wells (44) as is taught by the secondary reference and required of the primary reference of Tamai.

With respect to the use of a tube and collection vessel as required of claims 29/28, the reference of Genese et al. discloses that it is known in the art to communicate a collection chamber such as discharge channel (30) of the primary reference with a tube and waste container. The reference of Genese et al. discloses communicating the windage bowl (40) with a tube (204) and collection bottle (See column 12, lines 63-68).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a tube and collection vessel in communication with the discharge channel (30) of the reference of Tamai for the known and expected result of externally collecting liquid discharged from the vessels during a decanting step.

Response to Arguments

10. Applicant's arguments filed 02 April 2003 have been fully considered but they are not persuasive.

With respect to the rejection of claims 27, 28 and 30-32 under 35 USC 102(b) over the reference of American Hospital Supply, Applicants argue that the rejection is improper because the reference of American Hospital Supply *does not teach or suggest a centrifuge with a rotor which holds in a fixed position at least one reaction vessel tilted away from the axis of rotation.* Applicants argue that page 2, lines 90-96 and Figure 9 discusses inward displacement of the tubes to permit the removable head to be utilized as a tube storage rack when the head is removed from the well. Applicants stress that the recesses of the head assembly do not hold the tube in a fixed position tilted away from the axis of rotation as claimed in the present invention.

In response, while Applicants' characterization of the reference is correct, Figure 9 of the reference and page 2, lines 90-96, clearly disclose that the rotor of the device of American Hospital Supply, which is rotatable about an axis of rotation, is clearly capable of holding in a fixed position at least one reaction vessel tilted away said axis of rotation. Whether the vessel is held in this position during rotation of the rotor or while the rotor is not moving is immaterial since this feature disclosed by the reference meets the instant claim language.

With respect to the rejection of claims 27 and 30-32 under 35 USC 102(b) over the reference of Genese et al., Applicants argue that the rejection is improper because the reference of Genese et al. *does not teach or suggest a centrifuge with a rotor which holds in a fixed position at least one reaction vessel tilted away from the axis of rotation.* Applicants argue that column 6, lines 28-49, discusses how the trunnion, which holds the carrier and vial, is held at a negative angle when the coil is energized. Applicants stress that the carrier of the reference of Genese et al. does not hold the vessels in a fixed position because the carrier moves whether or not the coil is energized.

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In response, while Applicants' characterization of the reference is correct, Figure 2 of the reference and column 6, lines 28-49, clearly disclose that the rotor of the device of Genese et al., which is rotatable about an axis of rotation, is clearly capable of holding in a fixed position at least one reaction vessel tilted away said axis of rotation. Whether the vessel is held in this position only when the coils is energized is immaterial in view of the instant claim language because the vessel is held in a fixed position of the claimed tilt when the coil is energized.

With respect to the rejection of claims 28 and 30-32 under 35 USC 103 over the references of Genese et al. and American Hospital Supply, this rejection has been withdrawn.

With respect to the combination of the references of Tamai and American Hospital Supply, this rejection has been withdrawn.

With respect to the combination of the references of Tamai and Genese et al. under 35 103, Applicants argue that the combination is improper for several reasons.

Applicants first argue that neither of the references meets the claim limitation of a centrifuge device *with a rotor which holds in a fixed position at least one reaction vessel tilted away from the axis of rotation*. In response, the Examiner is of the position that the reference of Genese et al. meets this claim limitation for reasons already discussed above with respect to the 35 USC 102(b) rejection of record. As a result, the combination of the references of Tamai and Genese et al. as suggested would meet this claim limitation.

With respect to the motivation to combine the references, Applicants point out that the Examiner erred when pointing to column 9, lines 28-47, to show evidence of motivation because this section of the reference of Genese et al. "is totally unrelated to decanting of tubes". The

Examiner apologizes for this typographical error. The column should have been column 6 rather than column 9. This would be the same column referred to in the anticipation rejection.

Applicants further argue that there is nothing in either of the references that would suggest the combination of the references as advanced by the Examiner.

In response, the Examiner is of the position that motivation exists since the reference of Tamai employs a decanting step to empty the contents of the vessels of the microplates and the reference of Genese et al. teachings the use of a negative tilt to ensure the emptying of the content of a vessel during a decanting step. As a result, one of ordinary skill in the art would have been motivated to tilt the vessels of the reference of Tamai for the known and expected result discussed by the reference of Genese et al.

With respect to the combination of the references of Tamai, Genese et al. and American Hospital Supply under 35 103, this rejection has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on 6:40am-4:10pm; alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



William H. Beisner
Primary Examiner
Art Unit 1744

W.H.B.
June 26, 2003